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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,118	02/24/2000	Reuven Wachtfogel	NDS-4000 USA	7680
7590	01/10/2006		EXAMINER	
Welsh & Katz, Ltd. 120 South Riverside Plaza 22nd Floor Chicago, IL 60606			TRAN, HAI V	
			ART UNIT	PAPER NUMBER
			2611	
DATE MAILED: 01/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/515,118	WACHTFOGEL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hai Tran	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 October 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-133 is/are pending in the application.  
 4a) Of the above claim(s) 1-69, 74, 77-106, 108, 110, 120, 128, 130 and 133 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 70-73, 75-76, 107, 109, 111-117, 119, 121-127, 129, 131 and 132 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>all</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

### ***Declaration Under 37 CFR 1.131***

Applicant's declaration under 37CFR 1.131, dated 11/11/2005, is received and recorded.

### ***Response to Arguments***

Applicant's arguments with respect to claims 70-73, 75-76, 107, 109, 111-117, 119, 121-127, 129, 131-132 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 70 is rejected under 35 U.S.C. 102(b) as being unpatentable by Wilkins (US 5446919).

Claim 70, Wilkins discloses a broadcast system comprising:

a headend for broadcasting program material with commercials (Fig. 1A); and  
style="padding-left: 40px;">a multiplicity of receiver-decoders at user locations (Fig. 1B), each receiving  
said program material being broadcast and including a commercial unit for dealing  
with said commercials based at least partially on past viewing thereof, wherein each  
said receiver-decoder deals with said commercials by determining conditions  
pursuant to which they are viewed by a user (Col. 11, lines 25-50).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 71-73, 111, 112-114, and 121-124 are rejected under 35 U.S.C. 102(e) as being unpatentable by Alexander et al (US 6177931).

Claim 71, Alexander discloses a receiver-decoder (inherently in order to provide Ads and EPG, as shown I Fig. 1) for use with a broadcast system having a headend for broadcasting program material with commercials and a multiplicity of receiver-decoders at user locations (clearly a CATV system), said receiver-decoder comprising:

a receiver for receiving said program material being broadcast (see fig. 1);  
and

a commercial unit (Col. 33, lines 08-Col.35, lines 2) for dealing with said commercials based at least partially on past viewing thereof, wherein said receiver-decoder deals with said commercials by determining conditions pursuant to which they are viewed by a user.

Claim 72, Alexander discloses wherein said receiver-decoder deals with said commercials based at least partially on a history of viewing of said commercials via said receiver-decoder (Col. 34, lines 55-65+).

Claim 73 , Alexander further discloses wherein said receiver-decoder deals with said commercials based at least partially on a history of viewing of said commercials by multiple users (Col. 30, lines 38-45; Col. 33, lines 08-15).

Claim 111, the method claim is analyzed with respect to apparatus claim 71.

Claim 112, the method claim is analyzed with respect to apparatus claim 71.

Claim 113, the method claim is analyzed with respect to apparatus claim 72.

Claim 114, the method claim is analyzed with respect to apparatus claim 73.

Claim 121 is analyzed with respect to claim 71.

Claim 122 is analyzed with respect to claim 71.

Claim 123 is analyzed with respect to claim 72.

Claim 124 is analyzed with respect to claim 73.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 75-76, 109, 115-117, 119, 125-126, 127, 129 and 131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al (US 6177931) in view of Schaefer et al. (US 6490000).

Claim 75, Alexander further discloses wherein said receiver decoder deals with said commercials by determining conditions pursuant to which viewing of said commercials by user action (Col. 28, lines 30-60).

Alexander does not clearly disclose decoder deals with the commercials by determining conditions pursuant to which viewing of said commercials is obviated (made unnecessary) by user action.

Schaefer discloses the decoder deals with the commercials by determining conditions pursuant to which viewing of said commercials is obviated (made unnecessary) by user action (Col. 4, lines 42-Col. 5, lines 08). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alexander with the teaching of obviating commercials, as taught by Schaefer, so to be more effectively control the process of allowing or not allowing user to skip commercials (Col. 1, lines 50-Col.2, lines 15).

Claim 76, Schaefer further discloses wherein said receiver decoder deals with said commercials by determining conditions pursuant to which their viewing may be obviated independently of user action (Col. 4, lines 42-Col. 5, lines 08).

Claim 109 , Alexander does not disclose receiver-decoder deals with said one commercial by preventing the user from skipping said one commercial.

Schaefer discloses the receiver-decoder deals with the one commercial by preventing the user from skipping the one commercial (Col. 14, lines43- 56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alexander with Schaefer so to insure the advertisements are viewed by the user (Col. 2, lines 1-8).

Claim 115, the method claim is analyzed with respect to apparatus claim 75.

Claim 116, the method claim is analyzed with respect to apparatus claim 76.

Claim 117, the method claim is analyzed with respect to apparatus claim 109.

Claim 119, the method claim is analyzed with respect to apparatus claim 109.

Claim 125 is analyzed with respect to claim 75.

Claim 126 is analyzed with respect to claim 76.

Claim 127 is analyzed with respect to claim 107.

Claim 129 is analyzed with respect to claim 109.

Claim 131 is analyzed with respect to claims 111 and 117;

4. Claim 107 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins (US 5446919) in view of Schaefer et al. (US 6490000)

Claim 107, Wilkins does not disclose the receiver-decoder deals with said one commercial by preventing the user from skipping said one commercial.

Schaefer discloses the receiver-decoder deals with the one commercial by preventing the user from skipping the one commercial (Col. 14, lines43- 56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wilkins with Schaefer so to insure the advertisements are viewed by the user (Col. 2, lines 1-8).

5. Claim 132 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al (US 6177931) in view of Akiba et al. (US 6377745).

Claim 132, Alexander teaches every single limitation of claim 132 as discussed in claim 71.

Alexander does not specifically discloses "Dealing with the commercials, wherein, for at last one of the commercials, the dealing with the commercials comprises dealing with the one commercials by presenting alternative shortened versions of other commercials in response to a user request to view the one commercial in a FF or Fast-backward mode."

Akiba discloses the receiver-decoder deals with the one commercial by presenting a shortened version of said one commercial in response to a user request to view said program material in a fast-forward. If the FF function is not deactivated by the user, the system keeps presenting to user following commercials in sequence, one after the others (Col. 12, lines 53-Col. 13, lines 20). Therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alexander with Akiba so to control the reproduction speed in which the video data are read out successively at a predetermined read out interval thereby suppress the user's eye strain with efficient retrieval of the video data, i.e., display commercials in a shorted version.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT:ht  
12/23/2005



**HAITRAN  
PRIMARY EXAMINER**